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John T. Wassom JR.

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FISH & RICHARDSON P.C.

P.O. BOX 1022

MINNEAPOLIS, MN 55440-1022

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN T. WASSOM JR. and JERRY L. HARRIS

Appeal 2008-4761
Application 09/582,262
Technology Center 2100

Decided:¹ February 25, 2009

Before ALLEN R. MACDONALD, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-50. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing for this appeal was conducted on February 12, 2009. We reverse and enter a new ground of rejection under 35 U.S.C. § 101 against claim 1.

The Invention

The disclosed invention relates generally to managing navigation and history information in a computer application or utility (Spec. 1). Specifically, a computer application provides a global context for history and navigation to a user (Spec. 7).

Independent claim 1 is illustrative:

1. A method of managing navigation information in a computer application, the method comprising:

establishing a global context that can communicate with a plurality of resources, each resource residing in an associated local context;

communicating state information from one or more local contexts to a global context;

maintaining global navigation information for the plurality of resources using a single navigation interface based on the communicated state information, wherein the plurality of resources are separate and independent resources that include both browser and non-browser applications; and

presenting the global navigation information as an ordered list of the resources representative of an order in which the resources were accessed using the single navigation interface.

The Reference

The Examiner relies upon the following reference as evidence in support of the rejections:

Bodnar	US 6,544,295 B1	Apr. 8, 2003 (filed Nov. 18, 1996)
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The Rejections

1. The Examiner rejects claims 1-35 and 37-50 under 35 U.S.C. § 102(e) as being anticipated by Bodnar.
2. The Examiner rejects claim 36 under 35 U.S.C. § 103(a) as being unpatentable over Bodnar.

The Examiner's Findings

The Examiner finds that Bodnar “presents a manageable list of programs (non-browser application), Web sites (browser application) which the user accesses by a single click” (Ans. 15) and that the “Quick marks utility interface shows presenting the global navigation information [a] list of the resources representative [of an order] in which the resources were accessed using the single navigation interface” (Ans. 15).

The Appellants' Assertion

Appellants assert that “Bodnar does not describe or suggest that the global navigation information is presented as an ordered list of resources representative of an order in which the resources were accessed using the single navigation interface” (Supp. App. Br. 3-4) because “there is no indication that the buttons shown in Figure 3B, or the list of updated Quick marks generated by selecting the “What’s New” button and shown in Figure 7, are presented as an ordered list of the resources representative of an order in which the resources were accessed” (Reply Br. 2-3).

ISSUE

Did Appellants demonstrate that the Examiner erred in finding that Bodnar discloses presenting global navigation information as an ordered list of the resources representative of an order in which the resources were accessed using a single navigation interface?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Bodnar discloses a “Quick marks utility **380**” (col. 7, ll. 35-36) that “displays the user’s most frequently used programs, Internet sites, documents, and utilities as buttons” (col. 8, ll. 62-63).

2. Claims 1, 28, 42, and 44 require presenting global navigation or global-context history information as an ordered list of resources representative of an order in which the resources were accessed using a single navigation interface (Claims Appendix).

PRINCIPLES OF LAW

35 U.S.C. § 101

“A claimed process is . . . patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008). However, “even if a claim recites a specific machine or a particular transformation of a specific article, the recited machine or transformation must not constitute mere ‘insignificant postsolution activity’.” *Id.* at 957.

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) “In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from

practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” (*Id.*) (internal citations omitted).

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. at 1742 (2007). In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

ANALYSIS

Bodnar discloses a “Quick marks utility **380**” (col. 7, ll. 35-36) that “displays the user’s most frequently used programs, Internet sites, documents, and utilities as buttons” (col. 8, ll. 62-63). While Bodnar discloses that resources (i.e., frequently used programs, Internet sites, documents, and/or utilities) are displayed as buttons, we do not find, and the Examiner has not demonstrated, that Bodnar also discloses or suggests that the resources are displayed in “an order in which the resources were accessed” as recited in independent claims 1, 28, 42, and 44. Indeed, the Examiner has not shown that the resources of Bodnar are disclosed or suggested to be displayed in any particular order at all.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting independent claims 1, 28, 42, and 44, and of claims 2-27, 29-41, 43, and 45-50, which depend therefrom.

II. New Ground of Rejection -- 37 C.F.R. § 41.50(b)

Using our authority under 37 C.F.R. § 41.50(b), we reject claim 1 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.²

The Court of Appeals for the Federal Circuit recently held that “the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein” *In re Bilski*, 545 F.3d at 966. Appellants’ claim 1 does not transform physical subject matter. To the extent that Appellants’ claims may transform data, we note that transformation of data, without a particular machine, is insufficient to establish patent-eligibility under § 101. *See In re Bilski*, at 961 (“[E]ven a claim that recites ‘physical steps’ but neither recites a particular machine or apparatus, nor transforms any article into a different state or thing, is not drawn to patent-eligible subject matter.”).

Additionally, the claimed method is not both (a) limited to a practical application of a fundamental principle to transform specific data, and (b) limited to a visual depiction that represents specific physical objects or

² The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above under 37 C.F.R. § 41.50(b). However, we have not reviewed claims 2-50 to the extent necessary to determine whether these claims are also unpatentable under 35 U.S.C. § 101. We leave it to the instant Examiner to determine the appropriateness of any further rejections under § 101.

substances. *Bilski*, 545 F.3d 943, 962-63 (discussing the transformation of *In re Abele*, 684 F.2d 902 (CCPA 1982)).

We conclude that Appellants' claim 1 does not require a particular machine or apparatus and does not require the transformation of any article into a different state or thing. As such, claim 1 is not directed to statutory subject matter under 35 U.S.C. § 101.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have demonstrated that the Examiner erred in finding that Bodnar discloses presenting global navigation information as an ordered list of the resources representative of an order in which the resources were accessed using a single navigation interface.

DECISION

We reverse the Examiner's decisions rejecting claims 1-35 and 37-50 under 35 U.S.C. § 102(e) and claim 36 under 35 U.S.C. § 103.

In a new ground of rejection, we have rejected claim 1 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In addition to reversing the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of

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rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
37 C.F.R. § 41.50(b)

rwk

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022